



1638
MTC 6462.1
(35-21(17136))

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Venkatramesh et al.

Art Unit 1638

Serial No. 09/548,256

Filed April 12, 2000

For TRANSGENIC PLANTS CONTAINING ALTERED LEVELS OF STEROL
COMPOUNDS AND TOCOPHEROLS

Examiner A. Nelson

Confirmation No. 6162

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September 11, 2001

RESPONSE TO RESTRICTION REQUIREMENT
UNDER 37 C.F.R. § 1.111

TO THE ASSISTANT COMMISSIONER FOR PATENTS,

SIR:

This letter is in response to the Office action of June 11, 2001 requiring a restriction under 35 U.S.C. §§ 121 as between fifty-nine (59) groups of claims.

Applicants respectfully traverse the restriction requirement and respectfully request reconsideration under 37 C.F.R. § 1.111 of the restriction requirement and examination of the application on the merits in view of the response as set forth herein.

For a restriction requirement to be appropriate two criteria must be met. *See* MPEP § 803 (A-B). One, according to 35 U.S.C. § 121, is that a restriction is proper only if there are at least two independent and distinct inventions. Further, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." *See* MPEP § 803.

Applicants respectfully submit that examination of the claims of Group I (claims 1-12, drawn to constructs comprising specified sterol-related enzymes) with any of Groups II - LIX (remaining claims) does not impose a serious burden on the Office and that the groups as defined by the Office will involve substantially overlapping searches, as each construct included in Group I will need to be searched as part of any search strategy common to subsequent claim

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groups. In view of the foregoing, it is respectfully submitted that claims 1-70 (Groups I-LIX) be examined together on the merits.

In the event that the restriction is maintained, Applicants hereby elect to prosecute claims 1-12 (Group I) and to cancel claims 13-70 (Groups II-LIX) without prejudice. Applicants reserve the right to file a divisional application directed to any of the non-elected claims during the pendency of this application.

The Commissioner is hereby authorized to charge a one month extension fee and any underpayment or to credit any overpayment of government fees to Deposit Account No. 19-1345.

Respectfully submitted,



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